

Appl. No. 10/022,640
Amdt. dated November 20, 2003
Reply to Office Action of August 28, 2003

REMARKS/ARGUMENTS

Claim 16, like the withdrawn claims, is canceled without prejudice to the filing of one or more continuation or continuation in part or divisional applications.

The phrase "absent compressive force" has been removed from the specification. The Examiner has said that the rejection of claims 1 and 2 as anticipated by Fabel would be reinstated upon removal of the "new matter", and the rejection of claims 1-2 and 4 as unpatentable over Fabel in view of Freedman also would be reinstated.

Claims 1-2 and 4 are rejected under 35 USC 112 for reasons of record in paper No. 5. paragraph 13 and also for reasons of record in paper 4 paragraph 15 of the previous Office Action, mailed March 26, 2003.

Addressing the second grounds of rejection, as to the paragraph No. 13 of the previous rejection, there are no claims remaining in the case for examination that involve a "firm" adhesive. As to the paragraph No. 15, as to what constitutes a "cold flow" adhesive, it is submitted that the description in the application as filed is ample to advise those skilled in the art as to what is meant by "cold flow". On page 4 of the Specification, it says:

"Adhesive flow at ambient temperature is called "cold flow". **Then when wound into a roll, the compressive force exerted on the labels of the convolutions,

Page 8 of 13

Appl. No. 10/022,640
Amdt. dated November 20, 2003
Reply to Office Action of August 28, 2003

particularly the inner convolutions, *intensifies* the extrusion of the adhesive beyond the ends of the label."

Similarly, on page 8, it says:

"In any event, it will flow at ambient temperatures, that is to say, it possesses cold flow characteristics, and thus tends to exude or ooze beyond the area to which it is initially applied. This characteristic becomes all the more pronounce when the adhesive layer is compressed."

Cold-flow is defined by *Webster's New International Dictionary - 2nd Edition, Unabridged*, 1951 as, "to flow when cold." Cold flow is defined in the glossary of terms of the Pressure Sensitive Tape Council as "The tendency of a pressure sensitive adhesive to act like a heavy viscous liquid over long periods of time. Such phenomena as oozing and increases in adhesion are the result of this characteristic." See <http://www.pstc.org/publication/glossary.php>. Portions of the website, including the essential part of the glossary are enclosed.

It is to be noted that Freedman identifies the pressure sensitive adhesive it uses by manufacturer and trademark, column 18, lines 59-61. Fabel does not identify the adhesive at all, except as a "hot melt adhesive." Column 5 line 59. A hot melt adhesive does not cold flow.

Evidently, both Freedman and Fabel rely, properly, on the knowledge of those skilled in the art, as does applicant.

Page 9 of 13

Appl. No. 10/022,640
Amdt. dated November 20, 2003
Reply to Office Action of August 28, 2003

Emtech G1120 is described in the Emtech literature, as an extremely aggressive permanent rubber-based adhesive, not recommended for intricate die cutting. See <http://www.emtechfilms.com/products/adhesive>. A copy of a printout of an Emtech website describing G1120 is enclosed. An "extremely aggressive adhesive" is a very tacky adhesive, one which, as the specification indicates, exhibits cold flow, flowing at ambient, which is why the G1120 is not recommended for intricate die cutting.

As to the rejection on Fabel, there is nothing in Fabel to indicate that "the adhesive can be rubber-based which would include cold flow characteristic." On the contrary, the only places that Fabel mentions adhesive, and it never identifies the adhesive by composition or manufacturer, it says, column 5 lines 11-13, "This border allows for 'oozing or bleeding' of the adhesive *when exposed to heat from a laser printer --*" and at column 5 line 57-58, where it says "Preferably, an adhesive-free border can be provided to preclude oozing or bleeding of *hot-melt* adhesive from the edges of the sheet, ***".

Evidently, Fabel finds no problem in controlling the flow of the hot melt adhesive in response to heating, to remain within the border. Those skilled in this art are undoubtedly aware that the amount of flow is a direct function of the thickness of the adhesive-the thicker the adhesive layer, the greater the margin must be. The same thing is true of the cold flow adhesive.

Applicants are using cold flow adhesive because it provides superior adhesion to rubber tires, for example, but it poses the problem of creeping out the sides and ends of

Page 10 of 13

Appl. No. 10/022,640
Amdt. dated November 20, 2003
Reply to Office Action of August 28, 2003

the labels at ambient temperatures. Neither of the references faces the problem, and neither suggests any solution to the problem that they did not face. Die cutting a cold flow adhesive, not a liner or face sheet, is not obvious. The claims call for the adhesive layer to be die cut to define its boundaries.

It is submitted that the Examiner has not made a *prima facie* case of anticipation as required under 35 U.S.C. §102(b) in accordance with the MPEP, which states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q 2d. 1051, 1053 (Fed. Cir. 1987). MPEP §2131

Fabel describes neither a cold flow adhesive nor an adhesive that is die cut to define side and end margins that are set inwardly, respectively, from the side and end margins of the face sheet. Fabel makes no suggestion of die cutting the *adhesive*, even a hot melt adhesive. It is not obvious to die cut a cold flow adhesive.

If the Examiner should consider that the claims remaining in the case are unpatentable over Fabel in view of Freedman, it is submitted that the Examiner has not established a *prima facie* case of obviousness as required under the case law and in accordance with the MPEP, which states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach

Page 11 of 13

Appl. No. 10/022,640
Amdt. dated November 20, 2003
Reply to Office Action of August 28, 2003

or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. MPEP § 706.02(j) (emphasis added).

The MPEP also states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q.2d 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). MPEP § 2143.03 (emphasis added).

Neither Fabel nor Freedman suggests the use of cold flow adhesive, die cut to provide a free boundary. Freedman does not provide such a boundary, and Fabel discloses the use of a hot melt adhesive, the characteristics of which are different in vital respects from those of a cold flow adhesive, there being no creep or oozing until the adhesive is heated. Neither suggests die cutting the adhesive itself, and has been noted above, die cutting a cold flow adhesive is not obvious.

For the reasons that those skilled in the art will know exactly what the specification means by cold flow in this application, and that the cited art neither discloses nor suggests the subject matter of the claims remaining for examination in the case, reconsideration of the claims and their allowance are respectfully requested.

Appl. No. 10/022,640
Amdt. dated November 20, 2003
Reply to Office Action of August 28, 2003

Respectfully submitted,

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Page 15/16

Welcome to the Pressure Sensitive Tape Council

Page 1 of 1

The Pressure Sensitive Tape Council

50 Years of Advancing Pressure Sensitive Tapes 1953-2003

To better serve the needs of the pressure sensitive adhesive tape industry, the Pressure Sensitive Tape Council (PSTC) has developed this resource to enhance the availability of technical information within our industry. Available throughout the site is a variety of information, including details regarding our most popular publication, the 2002 - 03 Tape Products Directory.

Glossary of Terms

Page 1 of 1

Glossary of Terms

The following information is provided as a benefit to those who visit our web site. From A to Z, all industry related terms and definitions are listed below.

COLD FLOW

The tendency of a pressure sensitive adhesive to act like a heavy viscous liquid over long periods of time. Such phenomena as oozing and increases in adhesion are the result of this characteristic.

<http://www.pstc.org/>

PAGE 15/16 * RCVD AT 11/24/2003 3:54:15 PM [Eastern Standard Time] * SVR:USPTO-EFXXRF-1/3 * DNIS:8729306 * CSID:3149912178 * DURATION (mm:ss):04-10⁰³

Emtech Adhesive Selection Guide: Permanent Rubber-Based



Adhesive Selection Guide

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Corporate Literature
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Products
Empower Film Series
eFilm Series
Removable Film Series
Promofilm Series
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Express Pre-Slit Rolls

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Advanced Emulsion Adhesives

Selecting the right adhesives is an important first step in specifying the best film label stocks for your applications. To do this, you must first consider environmental conditions, the substrates to which the labels will be applied, and performance and appearance requirements.

Use this adhesives guide to begin your selection process. Then work with your Emtech Account Manager or Emtech Customer Service to determine the right facestock, adhesive and liner combination for your applications. Call 1-800-422-8116 or e-mail info@emtechfilms.com. They'll make it easy with complete information, samples, testing, ordering and shipment.

Select Adhesive Type:

Permanent Rubber-Based

Click an adhesive below for a listing of products which use that adhesive.

Adhesive Type	Application Temp (°F)	Service Temp (°F)	Adhesive Details
P1101 Permanent Rubber-Based	55 to 110	-25 to 155	Features <ul style="list-style-type: none"> • General Purpose Rubberbased • Exhibits Excellent Quick Tack • High Ultimate Adhesion to a Wide Variety of Surfaces • Meets Toy Labeling Specifications • Meets CONEG Specifications Substrates Low Surface Energy Plastics, Corrugated, Waxy Surfaces, Textured/Curved Substrates End User Markets Toy Labels, Drum Labels, Candle (Pad Labels) Description A general-purpose rubberbased adhesive that exhibits excellent quick tack and high ultimate adhesion to a wide variety of surfaces including polyolefin substrates. Ideal for drum labels. Meets toy labeling and CONEG Specifications.
P1140 Permanent Rubber-Based	35 to 120	-20 to 250	Features <ul style="list-style-type: none"> • Aggressive Tack • High Peel Substrates Open Celled Foam, Polyolefin End User Markets Foam Description A high performance adhesive designed for use in demanding environments where aggressive tack and high peel are required. This adhesive offers excellent adhesion to polyolefin and foam substrates.
P1110 Permanent Rubber Based	55 to 110	-25 to 155	Features <ul style="list-style-type: none"> • Ultimate Adhesion to a Wide Variety of Surfaces • General Purpose Rubberbased Substrates Textured Plastics, UV Coated Corrugated, Rubber, Metal/Aluminum, Low Surface Energy Plastics End User Markets Difficult Substrates, Waxy Surfaces, Retread Tires, Medical Foam, Rubber Hoses Description This adhesive was specially designed for labeling tires when used with tire wash. Exhibits high initial tack yet resists edge bleed and cold flow.
G1120 Permanent Rubber-Based	40 to 120	-20 to 140	Features <ul style="list-style-type: none"> • Extremely Aggressive • Not Recommended for Intricate Die Cutting Substrates Rubber, Waxy Surfaces, Concrete, Crates/Pallets End User Markets Tires, Shipping Labels Description An extremely aggressive rubber-based adhesive designed for use in tire label applications. Specially formulated for improved adhesion to heavily micro-vented and mold release treated tires.